

2814

03500.014298

PATENT APPLICATION



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*7/4 Electron  
J. Steptoe  
3-12-02*

In re Application of:

HIRAKU KOZUKA ET AL.

Application No.: 09/511,358

Filed: February 23, 2000

For: PHOTOELECTRIC  
CONVERSION DEVICE,  
AND IMAGE SENSOR AND  
IMAGE INPUT SYSTEM  
MAKING USE OF THE  
SAME

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Examiner: W. Louie

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Group Art Unit: 2814

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March 5, 2003

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Commissioner for Patents  
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT AND CONDITIONAL PETITION

Sir:

In response to the Office Action dated February 10, 2003, Applicants provisionally elect Group I (Claims 1-10 and 17) for initial prosecution, subject to the traversal of the restriction presented below.

Applicants submit that the restriction was improper for at least the reasons developed below.

The Office Action took the position that Groups I and II are related as combination and subcombination, that Groups II and III are related as combination and subcombination, and that Groups I and III are related in the same manner.

First, the relationship of Groups I and II is as subcombination and combination, not the reverse. Group II's Claim 11 includes the subject matter of Claim 1 as a subcombination thereof. The relationships of the other groups are believed similarly reversed in the Office Action.

Second, the two part test for supporting a restriction requirement based on the above relationship is that the Examiner must show that a combination as claimed:

(1) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness); **and**

(2) the subcombination can be shown to have utility either by itself or in other and different relations. See MPEP Section 806.05(c).

In this case, the first prong of the test has not been met.

The first prong of the two-way test delineated above is whether the combination requires the particulars of the subcombination for patentability. In this case, the relations between the combinations and subcombinations in question are of the type  $AB_{sp}/B_{sp}$ . That is, the details of the subcombination are recited within the combination in each case *with the exact same degree of specificity* as they are in the subcombination. In this case, the subject matter of each subcombination is in fact directly incorporated by reference into the respective combination by the fact that the combination, Claim 11 for example, is a dependent claim of the subcombination, Claim 1 for example.

The MPEP has a subheading at Section 806.05(c) stating the general rule: “ $AB_{sp}/B_{sp}$  No Restriction”. In the subsection introduced by that subheading, the MPEP makes clear that unless the Examiner can present *evidence* the combination is patentable over the prior art without the details of the subcombination, no restriction is proper. The

reason that the subheading states a general rule that restriction is improper whenever the relationship is  $AB_{sp}/B_{sp}$  is that at the stage of prosecution prior to the Examiner having done a search, the Examiner cannot possibly know whether the combination needs the details of the subcombination to be patentable over the prior art. Of course, in this case, the Office Action has presented no evidence whatsoever that the details of Claim 1 are not necessary for patentability of Claim 11 for example, or for any of the other Groups, and no prior art is cited that would provide such evidence.

Further, the Examiner has pointed to no “evidence claims” such as are mentioned in subsection III of Section 806.05(c) ( $AB_{sp}/AB_{br}(\text{Evidence Claim})/B_{sp}$ ). Moreover, as the MPEP makes clear, even in the presence of an evidence claim, if it is eventually determined during prosecution that the evidence claim is not patentable over the prior art, rejoinder must be considered. In any event, in the present case, absent the presence of any evidence claims, restriction is entirely improper.

To summarize, the Examiner must show that the combination is patentable *over the prior art* even without the particulars of the subcombination. If the Examiner cannot show this, no restriction is proper. See MPEP § 806.05(b) and (c).

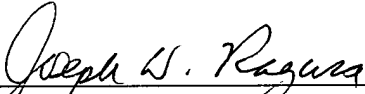
Moreover, a finding that restriction is proper in this case would be tantamount to a finding that the combinations are certainly patentable as they stand, in view of the finding that they do not need the specifics to be patentable, and a further finding that the combinations would be patentable even if the recitation of the subcombination is broadened. In such a case, before issuance of the required notice of allowance, the Examiner is requested to permit the claims to be broadened further and that those broadened claims be found to be allowable over the prior art as well. Unless the Examiner

is willing to immediately make such a finding, without even having done a search, the restriction must be withdrawn.

If the Examiner is not persuaded to withdraw the restriction in response to the foregoing, this paper should be treated as a Petition for reconsideration and should be forwarded to the appropriate persons for decision thereon. Although no fee is believed due in view of the errors in the Office Action outlined above, any fee that may be deemed to be due for the petition may be charged to Deposit Account No. 06-1205.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

  
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